

Application No. 08/900,964
Amendment dated June 7, 2004
Reply to Office Action dated April 7, 2004

REMARKS

Claims 26-45 are currently pending in the application.

The Examiner rejected Claims 26-28, 34-37, and 41-45 under 35 USC § 102(e) as being anticipated by Masuda et al. (USPN 5,978,041; hereinafter "Masuda"). The Examiner rejected Claims 29-33 and 38-40 under 35 USC § 103(a) for being unpatentable over Masuda in view of Lagoni (USPN 5,204,748). Applicant respectfully requests reconsideration of the application.

102(e) Rejection

In order for a reference to anticipate an invention, each and every element of the claimed invention must be found in a single reference. "Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 USPQ2d 1461, 1462 (Bd Pat App & Inter 1990). Applicant respectfully submits that Masuda does not anticipate Applicant's claimed invention because Masuda does not teach or disclose each and every element of the claimed invention.

Independent claim 26 recites, in relevant part, "a host computer system for running an application program", "a processor device for automatically generating a window control signal in response to said application program", and "generating a window information signal in response to said window control signal". Nothing in Masuda teaches "a host computer system for running an application program" and "a processor device for automatically generating a window control signal in response to said application program".

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The Examiner argues Masuda teaches "a host computer system for running an application program" and "a processor device for automatically generating a window control signal in response to said application program" in column 36, line 59 through column 37, line 17. Applicant notes this cited section states the following:

In the drawing, a program of the CPU circuit 34 as well as the picture data A are stored in ROM 3305 and the CPU circuit 34 performs processes such as setting of a composition area and execution of various operations on the basis of this program. In this case, the CPU circuit 34 sets the brightness level of the composition portion by software operation and by doing this, the hardware configuration becomes simpler than that of the embodiment shown in FIG. 31. Next, the software process in this embodiment will be explained by referring to FIG. 42. The CPU circuit 34 decides whether the area is a specific area, that is, a composition portion or not (Step 31200) first. When the area is not a composition portion, the CPU circuit 34 reads the picture data A from the ROM 3305 and transfers it to the picture composition means 33. When the CPU circuit 34 decides that the area is a composition portion, the CPU circuit 34 multiplies the picture data B read from the external input means 36 by the desired coefficient so as to adjust the amplitude and transfers it to the picture composition means 33 (Step 31201). By doing this, the picture B whose amplitude is adjusted is composed in the picture A by the picture composition means 33. This operation is performed until the aforementioned specific area ends and when the specific area ends (Step 31202), the CPU circuit 34 returns to Step 31200 again and transfers the picture data A to the picture composition means 33.

Applicant respectfully submits the cited section does not disclose or teach "a host computer system for running an application program" and "a processor device for automatically generating a window control signal in response to said application program". Nowhere in the cited section does it state a signal is generated in response to the application program. Instead, the cited section states that when "the CPU circuit 34 decides that the area is a composition portion, the CPU circuit 34 multiplies the picture data B read from the external input means 36 by the desired coefficient so as to adjust the amplitude and transfers it to the picture composition means 33." Thus, the

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cited section in Masuda does not teach generating a signal in response to an application program.

The cited section above describes Figure 41 in Masuda. To further support the Examiner's position regarding the control signal, the Examiner argues Figure 48 shows a "control signal" is provided to display device in response to an application program. However, the description of Figure 48 does not disclose how and why the control signal is generated. The description of the control signal is limited to "... a control signal passing through the interface 352 are supplied to the picture display means 350 from the picture signal output means 351." (see col. 38, lines 19-22). This brief description does not teach "a host computer system for running an application program" and "a processor device for automatically generating a window control signal in response to said application program".

The statements above regarding independent claim 26 also apply, in whole or in part, to independent claims 36, 43, and 45. Therefore, Applicant submits all of the independent claims are not anticipated by Masuda, and respectfully requests allowance of such claims.

Claims 27, 28, 34, and 35 depend from independent claim 26. Claims 37, 41, and 42 depend from independent claim 36. And claim 44 depends from independent claim 43. Since Masuda does not anticipate independent claims 26, 36, and 44, Applicant submits Masuda does not anticipate dependent claims 27-28, 34-35, 37, 41, 42, and 44.

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103(a) Rejection – Masuda and Lagoni

The Manual of Patent Examining Procedure (MPEP) states the following in Section 2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant submits that the combination of these two references does not render Applicant's claimed invention obvious, since the combination of references does not meet any of the three basic criteria listed above. The discussion below, however, will be limited to the third condition.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03. Applicant submits the combination of Masuda and Lagoni does not teach all of the claim limitations in Applicant's claims.

Claims 29-33 depend from independent claim 26, and claims 38-40 depend from independent claim 36. Applicant's statements with respect to Masuda apply to this rejection as well. Furthermore, the combination of Lagoni with Masuda does not teach or suggest all of the claims limitations in independent claims 26 and 36. If an independent claim is not rendered obvious by prior art, then any claim depending from the independent claim is not obvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) (see

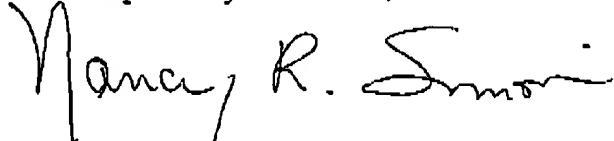
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also M.P.E.P. § 2143.03). Therefore, Applicant respectfully submits claims 29-33 and 38-40 are not obvious in view of the combination of Masuda with Lagoni.

In light of the amendments and discussion above, Applicants believe that all claims currently remaining in the application are allowable over the prior art, and respectfully requests allowance of such claims.

Respectfully submitted,

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